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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,033	08/21/2001	Alexander Rothacker	28655/37222	7797

4743 7590 02/26/2004

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EXAMINER

NGUYEN, TAM M

ART UNIT PAPER NUMBER

3764

DATE MAILED: 02/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,033

Applicant(s)

ROTHACKER, ALEXANDER

Examiner

Tam Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speyer (3,825,253) in view of Webber et al. (6,193,635), Rennex (4,971,305), Wendt (4,444,396), and in further view of the Choice1 Medical Distributors website ("Choice1").

1. As to claims 1 and 12-14, Speyer discloses an incremental weight system comprising a plurality of disk-shaped weights ranging in various weights having a center opening and a slot adapted to receive a standard barbell and a weight bearing cable respectively (see Figs. 2 & 3). Speyer does not disclose that the weights range in weight from about one-quarter ounce to about thirty-two ounces. Webber et al. disclose a weight stack apparatus that includes incremental weights of 5 pounds or less (see Col.6, lines 41-47). Rennex discloses an exercise device that utilizes finely incremented add-on weights that may include increments of 4 ounces (see Col. 3, lines 9-12 & Col. 4, lines 30-34), Wendt discloses an exercise device that utilizes weight plates of various sizes weighing 1, 2, 4, 8 and 16 ounces (SEE ABSTRACT), and Choice1 discloses a 36 ounce weight plate for exercise (see website c1md.com). At the time of the invention, it would have been obvious to a person of ordinary skill in the art

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to make Speyer's weight plates into any of an array of sizes from 1/8 ounce to 45 pounds since the use of such a range of sizes of weight plates is known in the exercise art as shown by the representative references above and the practice of incrementally adding weight plates of various sizes during exercise is well known in the art.

2. As to claims 2-7, Speyer, Webber et al., Rennex, Wendt, and Choice¹ disclose a modified weight system as described above. Webber, Rennex, Wendt and Choice¹ disclose weight plates having various ranges and sizes such as less than 5 pounds (less than 80 ounces), 1, 2, 4, 8, 16 and 32 ounces. They do not explicitly disclose that the weights range in size from about 1/4 ounce to about 32 ounces. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the weight plates into any of an array of sizes from less than 80 ounces up to 32 ounces, thereby including 1/2 and 1/4 ounce weight plates, since the use of such a range of sizes of weight plates and the practice of incrementally adding weight plates during exercise is well known in the art. Furthermore, where the range of article sizes disclosed in the prior art envelopes the recited range, and there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. In re Reven, 390 F.2d 997, 156 USPQ 679 (CCPA 1968).

3. As to claims 15-20, Speyer discloses an incremental weight system and inherently a method for exercising as substantially claimed wherein the system comprises a plurality of weights having a slot adapted to receive a weight bearing cable and a center opening adapted to receive a standard barbell (see Fig. 3). Speyer does not disclose that the specific size weight plates as claimed. Rennex, Wendt and

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Choice1 disclose weight plates having various ranges and sizes such as less than 5 pounds (less than 80 ounces), 1, 2, 4, 8, 16 and 32 ounces. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make the weight plates into any of an array of sizes from less than 80 ounces up to 32 ounces, thereby including $\frac{1}{2}$ and $\frac{1}{4}$ ounce weight plates, since the use of such a range of sizes of weight plates and the practice of incrementally adding weight plates during exercise is well known in the art.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webber et al. (6,193,635), Rennex (4,971,305), Wednt (4,444,396), and in further view of the Choice1 Medical Distributors website ("Choice1").

4. As to claims 8-11, Webber discloses an incremental weight system comprising a cable-type weight training apparatus and a plurality of weights having a center opening and a slot as substantially claimed (see Col. 6, lines 34-44, Col.7, lines 24-26 & Fig. 11). Webber does not disclose that the weights range in weight from about $\frac{1}{4}$ ounce to about 32 ounces including at least a $\frac{1}{2}$ ounce weight, a 1 ounce weight, a 2 ounce weight, a 4 ounce weight, a 8 ounce weight, a 16 ounce weight, and a 32 ounce weight. Rennex, Wendt and Choice1 disclose weight plates having various ranges and sizes such as less than 5 pounds (less than 80 ounces), 1, 2, 4, 8, 16 and 32 ounces. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to make Webber's add-on plate into any of an array of sizes from $\frac{1}{8}$ ounce up to 32 ounces since the use of such a range of weight plate sizes and the practice of incrementally adding weight plates during exercise is well known in the art.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

Regarding claims 1-7, the prior art clearly discloses the practice of incrementally adding weights of different sizes to an exercise device to enhance a user's workout.

Furthermore, the prior art also discloses that the incremental weights range in size from less than 5 pounds up to 45 pounds. Webber et al. disclose the practice of adding on incremental weight that is less than 5 pounds (implying a range that would cover 80 ounces and less) (see Col. 6, lines 11+).

6. The applicant asserts that the Wendt and Choice1 references do not suggest a motivation to combine because these references do not refer to weight training apparatuses. Choice1 clearly discloses "pulley weights" that "provide several levels of resistive exercise for specific muscles". The term pulley weights would imply that the plates are suitable for use with conventional exercise devices having weight stacks and thus incremental weight training. The Wendt reference clearly discloses that it is a weight training apparatus since it allows for the incremental addition of weights to "gradually increase the strength, stamina and suppleness of the muscles of a golfer." Even though this device is geared toward strengthening muscles for a golfer, it is inherently an apparatus that provides incremental weight training to a user's muscles.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Miller, Jr. 021, Brotman '522, Wendt '788, Bass '904, Heiman '675, and

Theplatemate.com each incremental weights of various sizes including 1/8 of an ounce and 10 ounces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam Nguyen whose telephone number is 703-305-0784. The examiner can normally be reached on Monday -Friday, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 703- 308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 12, 2004



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